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NOTICE OF ALLOWANCE AND FEE(S) DUE

77212 7590 06/16/2009

Cantor Colburn LLP - IBM Endicott
20 Church Street
22nd Floor
Hartford, CT 06103

EXAMINER

NGUYEN, DUSTIN

ART UNIT

PAPER NUMBER

2454

DATE MAILED: 06/16/2009

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/605,572

10/09/2003

Edward E. Kelley

FIS920030176US1

2571

TITLE OF INVENTION: METHOD, SYSTEM AND STORAGE MEDIUM FOR PROVIDING INTEROPERABILITY OF EMAIL AND INSTANT MESSAGING SERVICES

| APPLN. TYPE | SMALL ENTITY | ISSUE FEE DUE | PUBLICATION FEE DUE | PREV. PAID ISSUE FEE | TOTAL FEE(S) DUE | DATE DUE |
|----------------|--------------|---------------|---------------------|----------------------|------------------|------------|
| nonprovisional | NO | \$1510 | \$300 | \$0 | \$1810 | 09/16/2009 |

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

**Complete and send this form, together with applicable fee(s), to: Mail Mail Stop ISSUE FEE
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INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

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77212 7590 06/16/2009

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20 Church Street
22nd Floor
Hartford, CT 06103

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I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

| |
|--------------------|
| (Depositor's name) |
| (Signature) |
| (Date) |

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
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10/605,572 10/09/2003 Edward E. Kelley FIS920030176US1 2571

TITLE OF INVENTION: METHOD, SYSTEM AND STORAGE MEDIUM FOR PROVIDING INTEROPERABILITY OF EMAIL AND INSTANT MESSAGING SERVICES

| APPLN. TYPE | SMALL ENTITY | ISSUE FEE DUE | PUBLICATION FEE DUE | PREV. PAID ISSUE FEE | TOTAL FEE(S) DUE | DATE DUE |
|-------------|--------------|---------------|---------------------|----------------------|------------------|----------|
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nonprovisional NO \$1510 \$300 \$0 \$1810 09/16/2009

| EXAMINER | ART UNIT | CLASS-SUBCLASS |
|----------|----------|----------------|
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NGUYEN, DUSTIN 2454 709-206000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

(1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 _____

(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 _____

3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) : ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

- ☐ Issue Fee
☐ Publication Fee (No small entity discount permitted)
☐ Advance Order - # of Copies _____

4b. Payment of Fee(s); (Please first reapply any previously paid issue fee shown above)

- ☐ A check is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature _____

Date _____

Typed or printed name _____

Registration No. _____

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/605,572 | 10/09/2003 | Edward E. Kelley | FIS920030176US1 | 2571 |
| 77212 | 7590 | 06/16/2009 | EXAMINER | |
| Cantor Colburn LLP - IBM Endicott 20 Church Street 22nd Floor Hartford, CT 06103 | | | NGUYEN, DUSTIN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2454 | |
| DATE MAILED: 06/16/2009 | | | | |

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 778 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 778 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

| | | | |
|-------------------------------|------------------------|---------------------|--|
| Notice of Allowability | Application No. | Applicant(s) | |
| | 10/605,572 | KELLEY ET AL. | |
| | Examiner | Art Unit | |
| | DUSTIN NGUYEN | 2454 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 03/09/2009.
2. ☒ The allowed claim(s) is/are 1, 3-5, 7-20, 45 and 46, now renumbered as 1-20.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

/DUSTIN NGUYEN/
Primary Examiner, Art Unit 2454

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Applicants' attorney, Mr. Eric Baron, on 06/03/2009.

Please amends claims 1, 6, 45 and 46 as follows:

1. (Currently Amended) A method for providing interoperability of email and instant messaging services, comprising:

in response to:

receiving a request by an email recipient to respond to an email message using an instant message application, said email message received from an email sender;

retrieving an instant message address for said email sender from storage;

associating said instant message address of said email sender with an instant message composed by said email recipient;

Art Unit: 2454

transmitting said instant message to said instant message address using said instant message application, wherein an email address associated with said email sender is mapped to a corresponding instant message address associated with said email sender;

transmitting history data along with said instant message, said history data including communications exchanges previously conducted between said email recipient and said email sender;

determining whether said email sender is available to receive said instant message; and

in response to determining that said email ~~send~~ sender is unavailable to receive said instant message and in response to receiving a request from said email sender to defer, storing said instant message and periodically retransmitting said instant message;

wherein said communications exchanges include at least one of: email messages; instant messages; and attachments; and

in response to:

receiving a request by an instant message recipient to respond to an instant message using an email application;

retrieving an email address for an instant message sender from storage;

associating said email address of said instant message sender with an email message composed by said instant message recipient; and

transmitting said email message to said email address using said email application;

wherein an instant message address associated with said instant message sender is mapped to a corresponding email address associated with said instant message sender;

Art Unit: 2454

transmitting additional history data along with said email message, said additional history data including communications exchanges previously conducted between said instant message recipient and said instant message sender;

wherein said communications exchanges previously conducted between said instant message recipient and said instant message sender include at least one of: email messages; instant messages; and attachments; and

sending a notification of successful transmission to said instant message recipient.

6. (Cancelled).

45. (Currently Amended) A storage medium including machine-readable computer program code for providing interoperability of email and instant messaging services, the storage medium including instructions for causing a computer to implement a method, comprising:

in response to

receiving a request by an email recipient to respond to an email message using an instant message application, said email message received from an email sender;

retrieving an instant message address for said email sender from storage;

associating said instant message address of said email sender with an instant message composed by said email recipient;

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transmitting said instant message to said instant message address using said instant message application, wherein an email address associated with said email sender is mapped to a corresponding instant message address associated with said email sender;

transmitting history data along with said instant message, said history data including communications exchanges previously conducted between said email recipient and said email sender;

determining whether said email sender is available to receive said instant message;

and

in response to determining that said email ~~send~~ sender is unavailable to receive said instant message and in response to receiving a request from said email sender to defer, storing said instant message and periodically retransmitting said instant message;

wherein said communications exchanges include at least one of: email messages; instant messages; and attachments; and

in response to:

receiving a request by an instant message recipient to respond to an instant message using an email application;

retrieving an email address for an instant message sender from storage;

associating said email address of said instant message sender with an email message composed by said instant message recipient; and

transmitting said email message to said email address using said email application;

Art Unit: 2454

wherein an instant message address associated with said instant message sender is mapped to a corresponding email address associated with said instant message sender;

transmitting additional history data along with said email message, said additional history data including communications exchanges previously conducted between said instant message recipient and said instant message sender;

wherein said communications exchanges previously conducted between said instant message recipient and said instant message sender include at least one of: email messages; instant messages; and attachments; and

sending a notification of successful transmission to said instant message recipient.

46. (Currently Amended) An integrated messaging system for providing interoperability of email and instant messaging services, comprising:

in response to:

a host system comprises processor and memory for executing an integrated messaging system;

a link to a first client system associated with an email sender, said first client system executing a first email application and a first instant message application;

a link to a second client system associated with an email recipient, said second client system executing a second email application and a second instant message application;

Art Unit: 2454

a request to reply to an email message received from said email sender using an instant message application;

wherein in response to said request, said integrated messaging system performs:

retrieving an instant message address for said email sender from storage;

associating said instant message address of said email sender with an instant message composed by said email recipient;

transmitting said instant message to said instant message address using said instant message application, wherein an email address associated with said email sender is mapped to a corresponding instant message address associated with said email sender;

transmitting history data relating to said instant message, said history data being transmitted along with said instant message;

determining whether said email sender is available to receive said instant message; and

in response to determining that said email ~~send~~ sender is unavailable to receive said instant message and in response to receiving a request from said email sender to defer, storing said instant message and periodically retransmitting said instant message;

wherein said history data includes communications exchanges previously conducted between said email recipient and said email sender; and

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wherein further said communications exchanges include at least one of: email messages; instant messages; and attachments; and

in response to:

receiving a request by an instant message recipient to respond to an instant message using an email application;

retrieving an email address for an instant message sender from storage;

associating said email address of said instant message sender with an email message composed by said instant message recipient; and

transmitting said email message to said email address using said email application;

wherein an instant message address associated with said instant message sender is mapped to a corresponding email address associated with said instant message sender;

transmitting additional history data along with said email message, said additional history data including communications exchanges previously conducted between said instant message recipient and said instant message sender;

wherein said communications exchanges previously conducted between said instant message recipient and said instant message sender include at least one of: email messages; instant messages; and attachments; and

sending a notification of successful transmission to said instant message recipient.

Conclusion

Art Unit: 2454

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DUSTIN NGUYEN whose telephone number is (571)272-3971. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1519. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DUSTIN NGUYEN/
Primary Examiner, Art Unit 2454